



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,542	02/06/2002	Bo. T. Claridge	5007260-2	8006

21129 7590 03/01/2004

SPENCER, FANE, BRITT & BROWNE
1000 WALNUT STREET
SUITE 1400
KANSAS CITY, MO 64106-2140

EXAMINER

O'CONNOR, GERALD J.

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 03/01/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/068,542

Applicant(s)
Claridge et al.

Examiner
O'Connor

Art Unit
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 6, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke (US 6,112,191).

Burke discloses a method of investment comprising the steps of: at a point-of-sale location, displaying an option to perform an on-demand investment transaction; and transmitting a request to complete the on-demand investment transaction in response to an action by a purchaser at the point-of-sale location; and, at a central location, receiving the request to perform the on-demand investment; retrieving investment-preference information for the purchaser; and, completing the on-demand investment using the investment-preference information. See, in particular, Figures 4A, 4B, and 4C.

Regarding claim 2, the method of Burke further comprises the step of prompting the purchaser to designate an investment amount for the on-demand investment. See, in particular, column 5, line 63, to column 6, line 8.

Regarding claim 4, the method of Burke further comprises the step of temporarily accumulating the on-demand investment request until a predetermined completion time. See, in particular, column 3, lines 4-13.

Regarding claims 9-11, the method of Burke comprises associating a purchasing account with an investment account and using either the purchasing account or a source other than the purchasing account to contribute to the investment account. See, in particular, column 12, lines 11-16.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US 6,112,191), in view of Barton (US 6,164,533).

Burke discloses a method of investment, as applied above in the rejection of claim 1 under 35 U.S.C. 102(b), but Burke does not specifically disclose that the investment-preference information includes any predetermined investment amount for the on-demand investment, as the investment amount in the method of Burke is specified at the point-of-sale location at the time of the sale. However, Barton discloses a similar method of investment, which method

indeed includes that the investment-preference information includes a predetermined investment amount for the on-demand investment. See, in particular, column 5, lines 44-50.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to include in the investment-preference information a predetermined investment amount for the on-demand investment, in accordance with the teachings of Barton, in order to assist a user in achieving a budgeted investment goal by suggesting a default investment amount for each purchase being made.

Regarding claims 5-8, Burke does not disclose any investment limit/maximum, thus does not disclose accommodating an investment limit/maximum by including an investment total and a predetermined investment limit in the investment-preference information and, if the on-demand investment request would cause the limit/maximum to be exceeded, avoiding exceeding the maximum by either canceling the on-demand investment request or rolling the on-demand investment request over to a secondary/alternate investment account. However, Barton discloses a similar method of investment, which method indeed includes contributing the on-demand investment request to an investment account having a limit/maximum (an IRA). See, in particular, column 5, lines 44-50. Since canceling a deposit or rolling it over to a secondary/alternative account are self-evident and well known, hence obvious, steps to perform in order to avoid exceeding a limit/maximum of an investment account having a limit/maximum, such as an IRA, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to invest in an account having an investment limit/maximum,

in accordance with the teachings of Barton, and to accommodate the investment limit/maximum by not exceeding it, by including an investment total and a predetermined investment limit in the investment-preference information and, if the on-demand investment request would cause the limit/maximum to be exceeded, avoiding exceeding the maximum by either canceling the on-demand investment request or rolling the on-demand investment request over to a secondary or alternate investment account, as is self-evident and well known to do, in order to obey the law by complying with limits/maximums imposed on certain investment accounts, such as IRAs, by the law, and since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to the disclosure.
6. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

January 12, 2004

 (1-12-04)

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627